

Remarks:

Reconsideration of the application is requested.

Claims 1-35 are now in the application. Claims 16-35 have been added.

Newly added claims 34-35 are product claims. It is believed that process claim 17 and product claim 34 are sufficiently related as not to constitute different inventions requiring a restriction.

In item 4 on page 3 of the Office action, claims 1-2 and 13-15 have been rejected as being obvious over *Rutsch et al.* (US 4,298,556) in view of *Spehner* (US 5,232,779) under 35 U.S.C. § 103.

In item 5 on page 4 of the Office action, claims 3 and 11-12 have been rejected as being obvious over *Rutsch et al.* and *Spehner* in view of *Preston* (US 4,714,575) under 35 U.S.C. § 103.

In item 6 on page 5 of the Office action, claim 4 has been rejected as being obvious over *Rutsch et al.* and *Spehner* in view of *Miyake et al.* (US 5,354,397) under 35 U.S.C. § 103.

In item 7 on page 6 of the Office action, claims 5 and 6 have been rejected as being obvious over *Rutsch et al.* and *Spehner* in view of *Applicant's Admitted Prior Art* under 35 U.S.C. § 103.

In item 8 on page 6 of the Office action, claim 7 has been rejected as being obvious over *Rutsch et al.* and *Spehner* in view of *Teubert* (WO 94/09982) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

A process for producing a composite structural element for impact protection and insulation, which comprises:
providing a thin-section **wall** part;

....

In the second paragraph on page 3 of the Office action, the Examiner stated:

Rutsch et al. are directed to a method of molding fiber reinforced foam composites for use as auto-body parts, seats, helmets, luggage, etc. (Column 1, lines 8-11). Rutsch et al. teach an open mold containing an ABS foil (thin-section wall part) and fiber reinforcing elements (Figure 1 and Column 3, lines 1-4). Rutsch et al. teach a method comprising filling the mold with a reactive foam mixture (foaming agent), closing the mold, and foaming the mixture to encapsulate the fiber reinforcing elements (Figures 1-3 and Column 1, lines 12-22 and Column 3, lines 1-10 and Column 4, lines 8-25). It is noted Rutsch et al. do not specifically recite a set time delay. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rutsch et al. to use a reactive foam mixture with a set time delay to ensure foaming does not begin until after the open mold is filled with reactive foam mixture, i.e. the reactive foam mixture is distributed within the mold and closed prior to foaming.

(Emphasis added)

Regarding the "ABS foil" Rutsch et al. state in col. 2, lines 66-67, that an "exterior is desirably covered by an ABS foil of 0.8 mm thickness". No further disclosure or information is given in Rutsch et al. regarding the "ABS foil". There is no definition of the abbreviation or acronym "ABS" in Rutsch et al..

Applicant believes that an ABS foil, as disclosed in Rutsch et al., cannot be equated with a thin-section wall part. A wall is regarded as a stable three-dimensional structure, at least being able to stand on its own. A foil is a two-dimensional object, flexible at least in one dimension, unable to stand on its own.

In order to establish a *prima facie* case of obviousness by combining reference teachings, MPEP § 2143 requires that the combined prior art references must teach or suggest **all** the claim limitations. Clearly, *Rutsch et al.* in view of *Spehner* do not show a thin-section **wall** part, as recited in claim 1 of the instant application. Therefore, the invention as recited in claim 1 of the instant application is believed not to be obvious over *Rutsch et al.* in view of *Spehner*.

Newly entered claim 17 (similarly claim 34) calls for, *inter alia*:

A process for producing a composite structural element for a vehicle to dissipate and introduce an impact force acting upon the composite element to an adjoining load-bearing part of the vehicle, which comprises:

providing a thin-section wall part forming an outer skin of the vehicle and having an internal surface;

applying reinforcing elements to the internal surface of the thin-section wall part, the **reinforcing elements extending across and beyond the thin-section wall part overlapping the adjoining load-bearing part**; and

applying a binder having a foaming agent, and foaming the binder for embedding the reinforcing elements, to form the composite element.

Neither *Rutsch et al.* nor *Spehner* disclose or suggest "reinforcing elements extending across and beyond the thin-section wall part overlapping the adjoining load-bearing part", as recited in claims 17 and 34. Therefore, the invention as recited in claims 17 and 34 of the instant application is believed not to be obvious over *Rutsch et al.* in view of *Spehner*.

It is accordingly believed to be clear that *Rutsch et al.* in view of *Spehner*, do not suggest the features of claims 1, 17, and 34. Claims 1, 17, and 34 are, therefore, believed to be patentable over the art and because claims 2-16, 18-33, and 35 are ultimately dependent on one of claims 1, 17, and 34, they are believed to be patentable as well.

Considering the deficiencies of the primary reference *Rutsch et al.*, it is believed not to be necessary at this stage to address *Spehner* or the secondary references applied in the rejection of certain dependent claims, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying or combining the references as required by MPEP § 2143.

In view of the foregoing, reconsideration and allowance of claims 1-35 are solicited.

If an extension of time is required, petition for extension is herewith made.

Enclosed is Counsel's payment in the amount of \$ 270.00 for the extra 15 claims in excess of twenty in accordance with 37 CFR 1.16 (c) .

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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